

Serial No. 10/501,216
Docket No. 2515LN.eh
Ref. LEN.011

REMARKS

Entry of this Amendment is proper because it narrows the issues on appeal and does not require further search by the Examiner.

Claims 1-4, 6-11, 15-17, 19, and 20 are now pending in the application. Claim 1 has been amended by consolidating its coverage with that of claims 21 and 22, and so claims 21 and 22 have been canceled. Claims 4, 10, and 11 have been amended editorially to provide spelling consistent with that in the specification. Claims 5, 12-14, 16, and 18 have been canceled as redundant with amended claim 1.

Claim 22 was rejected under 35 U.S.C. §112, first paragraph. Claims 1-20 were rejected under 35 U.S.C. §103(a) as being unpatentable over Wittek, U.S. Patent No. 3,175,714 in view of Fuller et al., United States Patent No. 3,813,859. Claims 21-22 were rejected under 35 U.S.C. §103(a) as being unpatentable over Wittek in view of Fuller et al. and Kazanjian, United States Patent No. 2,735,562. These rejections are respectfully traversed.

THE 35 U.S.C. §112, FIRST PARAGRAPH REJECTION

Claim 22 was rejected under 35 U.S.C. §112, first paragraph, with the contention that the specification does not contain a written description of its subject matter. This subject matter has been consolidated with that of old claim 1 in amended claim 1 above.

The specification has been amended to include a written description of this subject matter. The Second Substitute Specification, submitted herewith, has this amendment on its page 3.

Serial No. 10/501,216
Docket No. 2515LN.ch
Ref. LEN.011

The Office Action states that the rejection is under 35 U.S.C. §112, first paragraph because the claimed subject matter was not described in the specification. However, the Office Action then contends that the claim presents new matter. Introduction of new matter is prohibited by 35 U.S.C. §132. Since the Office Action states that the rejection is under 35 U.S.C. §112, first paragraph, it is understood that the rejection is, in fact, based on the lack of written description of the subject matter of claim 22 in the specification.

The rejection is traversed.

MPEP §608 states the Applicant may rely for disclosure upon the specification with original claims and drawings, as filed. Claim 22 recited, and now claim 1 recites, that the support wheels support the retrieving sections with the plurality of retrieving disks adjacent the ground. As a consequence, the retrieving disks lift golf balls from the ground as the golf ball retrieving apparatus moves over the ground. The golf balls are then ejected into the receptacle baskets. Prior to the present Amendment, this subject matter was not described in the specification, and so the rejection under 35 U.S.C. §112, first paragraph, was correct. The amendment of the specification to add the subject matter overcomes the rejection under 35 U.S.C. §112, first paragraph.

Further, the subject matter is clearly disclosed in Figure 4 of the drawings, and so under MPEP §608, it is not new matter. Accordingly, old claim 22 was not, and amended claim 1 is not properly rejectable under 35 U.S.C. §132.

The rejection under 35 U.S.C. §112, first paragraph, was discussed during a telephone interview March 30, 2006 between Examiner Thomas J. Braham and the undersigned attorney. The undersigned attorney pointed out that the subject matter is disclosed in Figure 4.

Serial No. 10/501,216
Docket No. 2515LN.eh
Ref. LEN.011

However, Examiner Brahan indicated that he was not certain that the disclosure of Figure 4 was sufficient. Examiner Brahan also commented that patent drawings are not to scale.

Attached is a copy of Figure 4 on which are marked a line I that is perpendicular to the axis of wheel 16 and to the axis of disks 9 and a line II that is perpendicular to line I, and so is tangential to wheel 16. As can be readily seen, a space exists between the outer edges of the disks 9 and line II.

The scale of the disclosure in Figure 4 is irrelevant. What is relevant is the relative sizes and positioning of wheel 16 and disks 9. The attached marked copy of Figure 4 clearly shows that as the golf ball retrieving apparatus moves over the ground, support wheels 16 support the retrieving sections with the plurality of retrieving disks adjacent the ground to lift golf balls from the ground and eject the lifted golf balls into the receptacle baskets.

During the telephone interview, Examiner Brahan also contended that flexing of connection rail 15 as the apparatus traverses uneven ground may result in disks 9 contacting the ground. During travel over uneven ground, adjacent support wheels 16 contact the ground and support connection rail 15 between them. Admittedly, if a rock or bump in the ground is present between adjacent support wheels 16, it might *accidentally* contact one of the disks 9. However, such an accidental thing is not a bar to patentability. *Eibel Processing Co. v. Minnesota & Ontario Paper Co.*, 261 U.S. 454 (1923); *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 20 USPQ2d 1746 (Fed. Cir. 1991).

Thus, clearly, the subject matter of old claim 22 and amended claim 1 was disclosed in Figure 4 of the application as filed, and so is not new matter.

In view of the foregoing, the Examiner is respectfully requested to reconsider and

Serial No. 10/501,216
Docket No. 2515LN.eh
Ref. LEN.011

withdraw this rejection.

THE 35 U.S.C. §103(a) REJECTION

Claim 22 was rejected under 35 U.S.C. §103(a) as being unpatentable over Wittek in view of Fuller et al. and Kazanjian, United States Patent No. 2,735,562. In describing Kazanjian, the Office Action states: "The wheels support the retrieving sections from the ground and the disks (30) eject the balls into the baskets as the device moves, as recited in claim 22." This is incorrect.

Kazanjian has no disks. Kazanjian's component 30 is a set of hinges. See Kazanjian at column 3, lines 12-16. Kazanjian's drag links 32 direct golf balls to a plow or shoe 54 which deflects the golf balls into a tray or pan 45. See Kazanjian column 3, line 59 to column 4, line 35.

Kazanjian's Figures 6 and 7 clearly show that shoe 54 and pan 45 are supported on the same ground surface as wheel 29. Although the forward end of shoe 54 is directed upwardly, the shoe is still supported on the ground. There is nothing in Kazanjian's apparatus that is supported adjacent the ground by wheels 29.

Thus, combining Kazanjian with Wittek and Fuller would not result in or suggest the invention of claim 1 and its dependent claims.

Accordingly, independent claim 1 is allowable, as are dependent claims 2-4, 6-11, 15-17, 19, and 20.

Serial No. 10/501,216
Docket No. 2515LN.eh
Ref. LEN.011

THE SPECIFICATION

A Second Substitute Specification is submitted herewith. It includes an amendment on page 3 providing a written description of old claim 22, and thus of the subject matter added to claim 1. In addition, minor editorial amendments have been made on page 1 (underlining the heading "Background"), page 2 (adding a comma after "rail" in line 5), page 4 (inserting "each of" at line 5 of the first full paragraph to conform with the first line of that same paragraph), and page 5 (correcting "light angles" to "right angles" in line 2, correcting "beg" to "being" in line 2 of the second full paragraph, and correcting "common" to "correction" in line 5 of the second full paragraph). The undersigned attorney affirms that the Second Substitute Specification contains no new matter.

CONCLUSION

In view of the foregoing, Applicant submits that claims 1-4, 6-11, 15-17, 19, and 20, all the claims presently pending in the application, are patentably distinct over the prior art of record and are allowable, and that the application is in condition for allowance. Such action would be appreciated.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned attorney at the local telephone number listed below to discuss any other changes deemed necessary for allowance in a telephonic or personal interview.

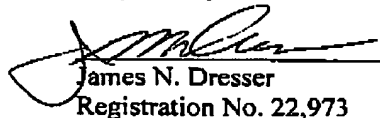
To the extent necessary, Applicant petitions for an extension of time under 37 CFR §1.136. The Commissioner is authorized to charge any deficiency in fees, including

Serial No. 10/501,216
Docket No. 2515LN.eh
Ref. LEN.011

extension of time fees, or to credit any overpayment in fees to Attorney's Deposit Account
No. 50-0481.

Date: March 31, 2006

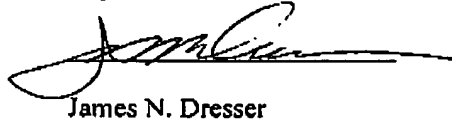
Respectfully Submitted,


James N. Dresser
Registration No. 22,973

**MCGINN INTELLECTUAL PROPERTY
LAW GROUP, PLLC**
8321 Old Courthouse Road, Suite 200
Vienna, Virginia 22182-3817
(703) 761-4100
Customer No. 21254

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that I am filing this Amendment Under 37 C.F.R. §1.116 by facsimile
with the United States Patent and Trademark Office to Examiner Thomas J. Brahan, Group
Art Unit 3652 at fax number 571-273-8300 this 31st day of March 2006.


James N. Dresser